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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/736,389
Filing Date: December 15, 2003
Appellant(s): CREAMER ET AL.

Gregory A. Nelson
(Registration # 30,577)
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 22 February 2010 appealing from the Office action mailed 13 August 2009.

Art Unit: 2446

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application: 1-3 and 25-30.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except

Art Unit: 2446

for the grounds of rejection (if any) listed under the subheading “WITHDRAWN REJECTIONS.” New grounds of rejection (if any) are provided under the subheading “NEW GROUNDS OF REJECTION.”

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant’s brief.

(8) Evidence Relied Upon

U.S. 2003/0014668	FACCIN ET AL.	01-2003
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U.S. 2004/0193712	BENENATI ET AL.	09-2004
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Pailer, R. et al., A Service Framework for Carrier Grade Multimedia Services using PARLAY APIs over a SIP System, Proceedings of the first workshop on wireless mobile internet, July 2001, Pages: 69 - 75.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 3, 25, 27-28, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Benenati (U.S. 2004/0193712) in view of Faccin (U.S. 2003/0014668) and further in view of Pailer (“A Service Framework for Carrier Grade Multimedia Services using Parlay APIs over a SIP system”).

Art Unit: 2446

Claims 2, 26, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Benenati (U.S. 2004/0193712) in view of Faccin (U.S. 2003/0014668), further in view of Pailer (“A Service Framework for Carrier Grade Multimedia Services using Parlay APIs over a SIP system”), and further in view of Applicant's admitted prior art (hereafter "AAPA").

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 3, 25, 27-28, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Benenati (U.S. Patent App. Pub. No. 2004/0193712) in view of Faccin (U.S. Patent App. Pub. No. 2003/0014668) and further in view of Pailer (“A Service Framework for Carrier Grade Multimedia Services using Parlay APIs over a SIP system”).

3. Regarding claims 1, 25, and 28, Benenati teaches a method of authenticating a mobile communication device within a mobile network, which is a voice network, and a wireless network, which is a data network. *See* Benenati at p. 1, paragraph 14. Benenati teaches providing a mobile communication device configured to communicate over the mobile network and the wireless network. *See id.* Benenati teaches the mobile communication device receiving

Art Unit: 2446

authentication data from a mobile service provider over the mobile network when the mobile communication device is within communication range of the mobile network. *See id.* at p. 4, paragraph 38 (“Upon verification of the signature the AAA entity authorizes the user and may send a key for encryption and a new key material to be used in future authentication process.”). Benenati teaches the mobile communication device forming a token using the authentication data received from the mobile service provider communications network and sending the token to a server via a wireless communications link over the wireless networks. *See id.* at p. 4, paragraph 39 (“thus it may become possible for client software at the user to automatically supply the user’s authentication credentials whenever the user moves between air interface technologies”). Benenati teaches the server interpreting the token and forming a request for authentication using data specified by the token; and the server sending the request for authentication of the mobile communication device to the mobile service provider. *See Benenati* at p. 3, paragraph 32-33 (“resolve the authoritative AAA server and to forward the authentication request message to the appropriate H-AAA server”). Benenati teaches the mobile service provider confirming or denying the request for authentication by sending a response to the server, the server receiving the response from the mobile service provider and sending a reply to the mobile communication device over the wireless communications link indicating whether the request for authentication was confirmed, and the mobile communication device receiving [[a]] the reply from the SIP server. *See Benenati* at p. 4, paragraph 38 (“Upon verification of the signature the AAA entity authorizes the user and may send a key for encryption and a new key material to be used in future authentication process.”).

Art Unit: 2446

Benenati does not teach that the authentication server is a Session Initiation Protocol (SIP) server. However, Faccin teaches that it is well known to use SIP for authenticating communication devices in a network. *See Faccin at fig. 1; Faccin at p. 2, paragraph 26.* It would have been obvious to one of ordinary skill to use Faccin's technique in Jones' system because Faccin teaches that the disclosed technique may be used to authenticate a subscriber in a mobile terminated call to increase system security. *See Faccin at p. 1, paragraph 10.*

Modified Benenati does not teach that the request for validation uses Parlay. However, Pailer teaches that it is well known map SIP functionality to Parlay services. *See Pailer, Abstract.* It would have been obvious to use Pailer's technique in Jones' system because Pailer teaches that the use of the Parlay APIs may speed up application development and increase interoperability. *See Pailer, Abstract.*

Regarding claims 3, 27, and 30, Benenati teaches that the wireless network is compliant with an 802.11 wireless communications protocol. *See id.*

4. Claims 2, 26, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Benenati (U.S. 2004/0193712) in view of Faccin (U.S. 2003/0014668), further in view of Pailer ("A Service Framework for Carrier Grade Multimedia Services using Parlay APIs over a SIP system"), and further in view of Applicant's admitted prior art (hereafter "AAPA").

Regarding claims 2, 26, and 29, AAPA teaches that the wireless network is compliant with at least one of an 802.16, 802.20, or 802.15 wireless communications protocol. *See present application at p. 2.* It would have been obvious to one of ordinary skill to use any of the wireless

Art Unit: 2446

standards taught by AAPA in Benenati's system because Benenati teaches that the disclosed invention may be applied to any transmission system. *See* Benenati at p. 1, paragraph 14.

(10) Response to Argument

The examiner summarizes the various points raised by the appellants and addresses them individually.

(A) *Appellants Argue:* It is noted that in Benenati a set of AA credentials from a user may be used to gain access to multiple networks. In contrast, in the present invention, authentication data from a mobile service provider, not from a user, is used to gain access to a wireless network.

In Response: The examiner respectfully submits that the combination of Benenati, Faccin and Pailer teaches the authentication entity of the WLAN (visited network) may need to interface with a pre-provisioned authentication database owned by the cellular wireless provider (e.g., the user's home ISP 150) (see Benenati, page 3, paragraph 27). And that independent visited networks that have Service Level Agreement[s] with the home network the ability to authenticate and obtain authorization from the existing back-office infrastructure of a particular service provider (see Benenati, page 3, paragraph 30). Benenati shows that authentication data from a mobile service provider is used to gain access to a wireless network.

Therefore, the combination of Benenati, Faccin and Pailer anticipates the claimed invention by disclosing each and every limitation claimed.

(B) Appellants Argue: Benenati also does not disclose that the mobile communication device includes a Session Initiation Protocol (SIP) user agent executing therein and builds a SIP referred by token using the authentication data received from the mobile service provider.

In Response: The examiner respectfully submits that the combination of Benenati, Faccin and Pailer teaches the mobile communication device (the mobile node) including a Session Initiation Protocol (SIP) user agent executing therein (after receiving a SIP INVITE request, the mobile node respon[d]s with a SIP response – see Faccin, page 3, paragraph 50); and the mobile communication device (the mobile node) building a SIP referred by token using the authentication data received from the mobile service provider (the mobile node calculates the parameter CALC_RESP, which is the parameter AuthData2 sent to the SIP server – see Faccin, page 4, paragraph 89).

Therefore, the combination of Benenati, Faccin and Pailer anticipates the claimed invention by disclosing each and ever limitation claimed.

(C) Appellants Argue: In fact, Benenati teaches away from running SIP on the user device (see paragraph [0034]: “If the user also runs IP Security (IPSec) or Session Initiation Protocol, an additional layer (Application layer) of authentication is also required. These mutli-layer authentications may cause a data session to pause while the terminal is engaged in authentication

Art Unit: 2446

requests, both upon initial connection and upon inter-technology handoff. This places a burden on the user and/or client software and increases delays and provisioning complexities.”)

In Response: The examiner respectfully submits that a reference is no less anticipatory if, after disclosing the invention, the reference then disparages it. The question whether a reference “teaches away” from the invention is inapplicable to an anticipation analysis. *Celeritas Technologies Ltd. v. Rockwell International Corp.*, 150 F.3d 1354, 1361, 47 USPQ2d 1516, 1522-23 (Fed. Cir. 1998) (The prior art was held to anticipate the claims even though it taught away from the claimed invention. “The fact that a modem with a single carrier data signal is shown to be less than optimal does not vitiate the fact that it is disclosed.”). See *Upsher-Smith Labs. v. PamLab, LLC*, 412 F.3d 1319, 1323, 75 USPQ2d 1213, 1215 (Fed. Cir. 2005)(claimed composition that expressly excluded an ingredient held anticipated by reference composition that optionally included that same ingredient); see also *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1349, 51 USPQ2d 1943, 1948 (Fed. Cir. 1999) (Claimed composition was anticipated by prior art reference that inherently met claim limitation of “sufficient aeration” even though reference taught away from air entrapment or purposeful aeration.). See MPEP § 2131.05.

Benenati discloses the use of SIP on page 4, paragraph 34. Therefore, it can be relied upon for teaching that element of the claim language.

“The use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of the art, relevant for all they contain.” *In re Heck*, 699 F.2d 1331, 1332-33, 216 USPQ 1038, 1039 (Fed. Cir. 1983) (quoting *In re Lemelson*, 397 F.2d 1006, 1009, 158 USPQ 275, 277 (CCPA 1968)). A reference may be relied upon for all that it would have reasonably suggested to one

Art Unit: 2446

having ordinary skill the art, including nonpreferred embodiments. *Merck & Co. v. Biocraft Laboratories*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), cert. denied, 493 U.S. 975 (1989).

(D) Appellants Argue: Benenati further does not disclose the specific authentication steps occurred between the SIP server and the mobile service provider. More particular, Benenati does not disclose “the mobile communication device sending the token to a SIP server via a wireless communications link over the wireless network; the SIP server interpreting the token and forming a Parlay request for authentication using data specified by the token; the SIP server sending the request for authentication of the mobile communication device to the mobile service provider; and the mobile service provider confirming or denying the request for authentication by sending a response to the SIP server,” as recited in independent claims of the instant application.

In Response: The examiner respectfully submits that the combination of Benenati, Faccin and Pailer teaches the mobile communication device sending the token to a SIP server via a wireless communications link over the wireless network (the mobile node calculates the parameter CALC_RESP, which is the parameter AuthData2 sent to the SIP server – see Faccin, Fig. 1, elements S6 and S7; page 4, paragraph 89); the SIP server interpreting the token (Thus, in step 8 the verification is performed by comparing the value of RESP with the value of CALC_RESP – see Faccin, Fig. 1, element S8; page 4, paragraph 89) and forming a Parlay request (a complete mapping of SIP messages to PARLAY GCCS events and a complete

Art Unit: 2446

mapping of SIP functionality to PARLAY the User Status Service (USS) from the PARLAY Mobility Interfaces from the PARLAY Mobility Interfaces – see Pailer, page 70, 5th full paragraph) for authentication using data specified by the token (Thus, in step S8 the verification is performed by comparing the value of RESP with the value of CALC_RESP – see Faccin, Fig. 1, element S8; page 4, paragraph 89); the SIP server sending the request for authentication of the mobile communication device to the mobile service provider (The SIP server...forwards the request including AuthData1 and AuthResp to the SIP proxy in step S4a. In step S11 the SIP proxy verifies AuthData2, and after a positive verification... – see Faccin, Fig. 4, elements S4a and S11; page 5, paragraphs 95 and 108); and the mobile service provider confirming or denying the request for authentication by sending a response to the SIP server (the SIP server may send a corresponding failure message to the caller – see Faccin, page 4, paragraph 86).

(E) *Appellants Argue:* No motivation or suggestion can be found in Benenati to combine [the terms SIP protocol and Parlay] with Benenati's invention.

In Response: The examiner respectfully submits that in this case, it has been shown that Benenati is directed to a common authentication and authorization (AA) between networks having disparate access technologies may enable a seamless user transition between the networks (see Benenati, Abstract). In analogous art, Faccin is drawn to a method of performing authentication of a subscriber, comprising the steps of sending a session invitation message to the subscriber equipment, the session invitation message including authentication information,

Art Unit: 2446

and performing an authentication procedure in the subscriber equipment by using the authentication information (see Faccin, Abstract). In additionally analogous art, Pailer details a technology that combines some of the features of the fixed telephone network, mobile radio, and the Internet. The paper proposes a mapping of SIP functionality to PARLAY services (see Pailer, Abstract).

The motivation to combine Benenati and Faccin was given in the rejection as “to authenticate a subscriber in a mobile terminated call to increase system security (Faccin, page 1, paragraph 10).” The motivation to combine Benenati, Faccin and Pailer was given in the rejection as “to speed up application development and increase interoperability (Pailer, page 69, Abstract).”

Moreover, the KSR decision supports the rationale that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention. Benenati was used as the primary reference, which is seen as disclosing all of the claimed subject matter except for that detailing the authentication server as a Session Initiation Protocol (SIP) server, and the use of Parlay. However, the Session Initiation Protocol (SIP) server limitations are covered by Faccin. The Parlay limitations are covered by Pailer. So all of the component parts of the claim are known in Benenati, Faccin, and Pailer. Thus, it would have been obvious to one having ordinary skill in the art to use the Session Initiation Protocol (SIP) server elements taught by Faccin and the use of Parlay taught by Pailer with the system of enabling common authentication and authorization between networks discussed in the Benenati reference, since the

Art Unit: 2446

Session Initiation Protocol (SIP) server elements and the use of Parlay could be used in combination with an authentication and authorization service to achieve the predictable results of providing interoperability and simplifying roaming between disparate network technologies.

Art Unit: 2446

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Benenati, Faccin, and Pailer.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejection should be sustained.

Respectfully submitted,

/Alicia Baturay/

Examiner, Art Unit 2446

/Jeffrey Pwu/

Supervisory Patent Examiner, Art Unit 2446

09 June 2010

Conferees:

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Application/Control Number: 10/736,389

Page 15

Art Unit: 2446

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